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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,243	10/16/2001	Peter F. Reile	FSHR-042/00US 063518-2286	2235
22903 7590 06/26/2008 COOLEY GODWARD KRONISH LLP ATTN: PATENT GROUP Suite 1100 777 - 6th Street, NW WASHINGTON, DC 20001				
EXAMINER NGUYEN, DAT				
ART UNIT		PAPER NUMBER		
3714				
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06/26/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/977,243

**Applicant(s)**

REILE ET AL.

**Examiner**

DAT T. NGUYEN

**Art Unit**

3714

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19, 21-28, 31-41, 43-55 and 57-66 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-19, 21-28, 31-41, 43-55 and 57-66 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/3508)  
4) ☐ Interview Summary (PTO-413)  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is responsive to the amendments filed on 03/27/2008 in which applicant amends claims 1, 10, 19, 22, 23, 25-27, 31, 32 and 43, cancels claims 29, 30 and 56, adds new claims 63-66 and responds to claim rejections. Claims 1-19, 21-28, 31-41, 43-55 and 57-66 are pending.

### ***Claim Rejections - 35 USC § 112***

Claims 1, 10, 22, 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite that the toolbar is fixedly disposed on said touch screen, however there is no disclosure in the applicant's specification to support a "fixedly disposed" or "fixed" tool bar on the touch screen. In the spirit of furthering prosecution, the examiner will interpret the limitations as a screen in which the toolbar appears in a general area as that taught by Hainey II.

Claim 64 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim recites that the second activity is a game activity. There is disclosure that games may be played on the handheld, however

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they have not been disclosed in such a manner as required by the claims wherein the game is the second activity that is made available or unavailable and dependent on the selection of a first activity.

Claim 1 recites the limitation "said plurality of activities" in which no prior reference to a plurality of activities has been mentioned, drawing activities were mentioned, but it is unclear as to whether applicant is referring to the previously mentioned drawing activities or some different set of activities. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-19, 21-28, 31-41, 43-55 and 57-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hainey, II (US 2001/0038999) in view of Microsoft Office Shortcut Bar and Microsoft Paint (copyright 1981-1998 version 4) and further in view of SAMS Teach Yourself Paint Shop Pro 5, Michael T. Clark.**

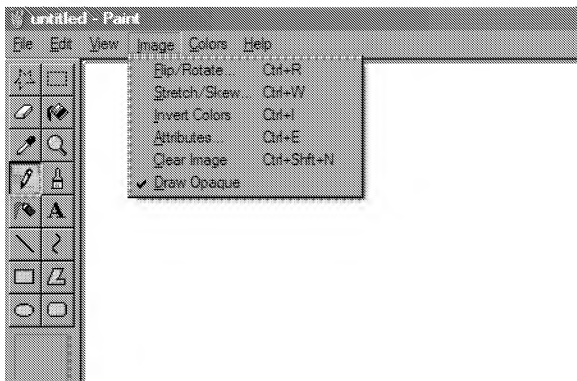
The rejection as stated in the office action dated 09/28/2007 is retained, modified and incorporated herein.

Regarding the amendments to the claims Hainey II teaches the use of a touch screen (feature 13, [0035]), the fixedly disposed toolbar, the tool bar of Hainey is "fixedly disposed" in figure 3. Furthermore the tool bar of Microsoft Paint is also fixedly disposed wherein the options and menus are stationary and non-movable.

Regarding the limitations of "a plurality of drawing activities displayed on the touch-screen display in response to one of said plurality of activities displayed on the touch-screen being touched", Hainey II teaches the very same limitation in [0035] wherein he states "each icon selected opens a window... providing further options available within the selected category."

Regarding the limitation of "said second interactive tool being on of activated or inactivated based on the selection of said one of said plurality of activities," as discussed above, Hainey II teaches that when a player selects an icon, additional menus or second interactive tools become available for selection from the selection of the first icon [0035].

Regarding claim 10, the full erase tool has been taught by Microsoft Paint in the form of a "clear image function", which can be utilized by pressing the Ctrl+Shift+N keys simultaneously which erases the entire screen. The user may also access the function under the "image" tab at the top.



Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the full screen erase function with the drawing system of the prior art in order to allow users to quickly start over on a project without having to close and create a new file.

Regarding the limitations of claim 26, the limitations of the starter scene is met by the selection of the image type as discussed in the previous office action which is incorporated herein. The user selects from a plurality of image types (page 44-46 of Clark) wherein corresponding to each image type, the characteristics of an interactive tool on the toolbar is modified (in this case the color wheel) based on the selection of the image type.

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Regarding claim 31, the limitations of the cartridge including removable memory are met by Hainey II in feature 18, an external cartridge connector for use with flash memory for plug and play cartridges [0031].

Regarding claim 63, wherein the second activity is a drawing activity, Hainey II [0035], drawing tools.

Regarding claim 65, the user selects from a plurality of activities (figure 4 feature 50) from which the user can select an art lesson or a starter scene (figure 4, feature 60).

Regarding claim 66, the prior art is silent regarding the full screen erase function having selectable animated erase options, however it is notoriously well known in the art to allow users to select their animation options and therefore it would have been obvious to one of ordinary skill in the art at the time of invention to allow users to select an animation for which to view while the system erases their screen. A good example of this would be allowing users to select from animated screen savers which have been known in the art prior to applicant's invention wherein the computer system displays an animation while it is performing a secondary task (in this case protection of screen burns) however the teaching is relevant since in this application the task is the erasure of the screen whereby offering some entertainment value to the user while the system performs a normally mundane task.

### ***Response to Arguments***

Applicant's arguments filed 03/27/2008 have been fully considered but they are not persuasive.

Applicant's arguments towards claims 1 and 43 merely state that the prior art fails to teach the limitations and a recitation of the examiner's discussion of the Clark reference without any further arguments or discussion as to why the prior art fails to meet the claimed limitations. Applicant goes further to attack the references individually and fails to consider the references as a whole. In response to applicant's piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references.

Hainey II teaches the touch-screen display along with the fixedly disposed toolbar [figure 3, feature 13 and [0035]], Hainey further teaches that a sub selections are made available upon selection of drawing icons [0035].

Clark teaches menus and sub menus wherein selection so certain menu options alter the availability and attributes of sub menu options.

Regarding arguments drawn towards the fixedly display of the toolbar being interpreted as the toolbar being displayed even while the handheld is turned off, the examiner respectfully disagrees. Although applicant can be his/her own lexicographer and define terms as they see fit, there has been no such definition made for the term "fixedly" in the applicant's specification. In fact, the specification does not even make mention of the tool bar being fixed (please refer to the 112 rejection above). Therefore the examiner must give the claims their broadest reasonable interpretation in that the menus/toolbars are substantially stationary as met by the prior art and discussed in further detail above.



Regarding claim 19, the prior art meets the claimed limitation in that the color wheel of Clark only displays colors available for selection based on the previous selection. Inherently there must be some determination made prior to the display of the relevant color options.

Regarding claim 22, Hainey II teaches that the memory cartridges can add additional lessons for the user to select (second activity applications) when additional memory cartridges are inserted [0031].

Regarding arguments towards claim 26, please see the discussion above.

Regarding arguments towards claim 31, as stated previously the user can selection from a plurality of drawing lessons (interpreted as a second drawing activity), the lessons are to be used independent of other drawing activities since they have little relevance with one another. Furthermore, please see discussion of claim 22.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAT T. NGUYEN whose telephone number is (571)272-2178. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/  
Primary Examiner, Art Unit 3714

Dat Nguyen